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First Named Inventor	Kenyon et al.
Art Unit	2122
Examiner Name	Nguyen-Ba, Hoang-Vu A.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



In re Application for:

Kenyon et al.

Application No.: 09/768,658

Filed: January 23, 2001

For: ASYNCHRONOUS SOFTWARE
UPDATE

Examiner: Nguyen-Ba, Hoang-Vu A

Art Group: 2122

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Appellant's Brief Under 37 C.F.R. §1.192 In Support Of
Appellant's Appeal To The Board Of Patent Appeals And Interferences

Dear Sir:

The Appellants hereby submits this Brief in support of their appeal from a final decision by the Examiner, mailed August 26, 2004, in the above referenced case. This final decision was in response to arguments filed June 24, 2004. Appellants filed a response to the Final Office Action on October 20, 2004. The Examiner responded with an Advisory Action on November 23, 2004, maintaining the rejections. Appellants respectfully request consideration of this appeal by the Board of Patent Appeals and Interferences for allowance of the present patent application.

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Attorney's Docket No.: 109910-130358
Application No.: 09/768,658

IPG No. P009
SEA/109910/130358/MMC/331724.1

(1) Real Party In Interest

The real party in interest is WildTangent, Inc, a corporation of Delaware, having its primary place of business at 18578 NE 67th Court, Redmond, WA 98052.

(2) Related Appeals And Interferences

To the best of Appellants' knowledge, there are no appeals or interferences related to the present appeal, which will directly affect, be directly affected by, or have a bearing on the Board's decision.

(3) Status Of The Claims

Claims 1-24 were rejected in the Final Office Action dated August 26, 2004. Claims 1-24 remain pending herein and are reproduced, as pending, in Appendix A.

(4) Status of Amendments

No claim amendments have been made since the mailing date of the final rejection.

(5) Summary of the invention

The present invention provides a method and apparatus for asynchronous software update. Embodiments of the present invention include a server (software supplier) 102 that accepts a periodic check in by a client computer 132 to determine if the client

computer's software needs to be updated as depicted in FIGS. 1a to 2a. The server 102 then provides the client computer 132 with a task list 154 listing a number of tasks, as determined needed, to be asynchronously performed at a later point or later points in time by the client computer 132 to update the client computer's own software as depicted in FIGs 1a to 1b. See page 7, lines 9 - 20 and lines 24 and 25; page 8, lines 1 and 2; and page 9, lines 7 - 22.

(6) Issues Presented

- I. Whether claims 1-24 are patentable under 35 U.S.C. §102 over *U.S. Patent No. 5,742,829* to Davis et al. (*hereinafter "Davis"*).

(7) Grouping of claims

For purposes of this appeal, based on the above listed grounds of rejection, the claims stand or fall together as follows:

Claims 1-24 stand or fall together as Claim Group I.

(8) Arguments

Rejection of claims 1-14 under 35 U.S.C. §102 was improper because such claims are patentable over Davis.

Claim 1 of the present invention cites:

In a server, a method of operation comprising:
accepting check in by a **client computer** at a first point in time to determine if the client computer's software needs to be updated; and
providing the **client computer** with an update task list listing one or more tasks to be performed by the **client computer asynchronously at a later point or later points** in time to update the **client computer's** software, if it is determined that the client computer's software is to be updated. (*emphasis added*)

Accordingly, claim 1 requires at least in part

- (1) The "check in" is for determining whether the checking-in client computer's software needs to be updated,
- (2) The "update task list" is provided by the server computer receiving the check-in, and listing the one or more tasks to be subsequently performed by the checking-in client computer.

The Examiner cites *Davis* as anticipating claim 1 under 35 U.S.C. §102(b). It is well settled that anticipation under 35 U.S.C. §102 requires the disclosure in a single piece of prior art of **each and every** limitation of a claimed invention. *Electro Med. Sys. S.A. v. Cooper Life Sciences*, 34 F.3d 1048, 1052, 32 USPQ2d 1017, 1019 (Fed. Cir.

1994). Thus to anticipate the present invention, *Davis* must disclose every element listed above.

In section 5 of the Final Office Action, the Examiner reasoned for art rejection purposes, claimed element **server** is equated with **Site Server 202** (Figure 3A) and claimed element **client computer** with **Client Server 215** (Figure 3B). Further, the Examiner interpreted the two recited method steps are to be performed by a server, not by a client. Therefore, the required limitations are anticipated, since Scheduler 312 (Figure 3A) schedules software update tasks to be performed by the Client Server (see Figure 3B, item SMSLS Batch File 352 which involves Client Setup Executable 354 that install software onto the client computer).

In the Advisory Action, the Examiner reiterated that

the claimed feature of “providing the client computer with an update task list” reads on Davis’ feature of “retrieving a current list of software to be loaded onto the client.”

Respectfully, the Examiner’s reasoning is faulted. In *Davis*, Client Server 215 is responsible for installing software on Client Computers 214 within a domain of its responsibility (see e.g. col. 8, lines 56-67; and col. 9, lines 1-14). To the extent that Scheduler 312 of Site Server 202 schedules software installation tasks to be performed by Client Server 215,

a) the software installation tasks are not for updating the software of Client Server 215 (they are for updating Client Computers 214 within the domain Client Server 215 is responsible for);

b) the software installation tasks are not provided to Client Server 215, as a result of Client Server 215 checking in with Site Server 202, in particular, not as a result of Client Server 215 checking in to determine if the software of Client Server 215 needs to be updated.

In *Davis*, the determination of whether the software of Client Computer 214 needs to be updated is performed by Client Server 215, when Client Computer 214 attempts to log into the domain Client Server 215. Assuming arguendo that the “log in” can be read as the required “check in”, *Davis* nonetheless failed to anticipate the required “providing task list” operation, as *Davis* merely teaches Client Server 215 locally retrieving an installation task list for itself to be used by client setup executable 354 running on Client Server 215; and, Client Server 215, by way of the client setup executable 354, immediately installing the required software on Client Computer 214 accordingly. (see e.g. col. 13, lines 47-50; and col. 14, lines 7-38). In *Davis*, Client Server 215 neither provides the task list to Client Computer 214, nor having Client Computer 214 perform the installation tasks asynchronously at a later point or later points in time.

Thus, for at least the reasons set forth above, independent claim 1 is patentable over *Davis*.

Independent claims 8, 13, and 20 contain substantially the same limitations as discussed above with respect to claim 1. Thus, Appellants submit that the reasoning presented above with respect to claim 1 similarly applies to 8, 13, and 20. Therefore, for at least the reasons discussed above, Appellants respectfully submit that claims 8, 13, and 20 are likewise not anticipated by *Davis*.

Given that claims 2-7, 9-12, 14-19, and 21-24 depend from claims 1, 8, 13, and 20, Appellants respectfully submit that claims 2-7, 9-12, 14-19, and 21-24 are likewise not anticipated by *Davis* for at least the reasons discussed above.

(9) Conclusion

Appellants respectfully submit that all the appealed claims in this application are patentable and request that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims.

This brief is submitted in triplicate, along with a check for \$500.00 to cover the appeal fee for one other than a small entity as specified in 37 C.F.R. §1.17(c). We do not believe any fees, in particular extension of time fees, are needed. However, should that be necessary, please charge our Deposit Account No. 500393. In addition, please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,
Schwabe, Williamson & Wyatt, P.C.

Dated: 1/14, 2005


Mark C McClure
Registration No. 53,857

APPENDIX A – CLAIMS AS PENDING

1. In a server, a method of operation comprising:
 - accepting check in by a client computer at a first point in time to determine if the client computer's software needs to be updated; and
 - providing the client computer with an update task list listing one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software, if it is determined that the client computer's software is to be updated.
2. The method of claim 1, wherein the method further comprises determining if the client computer's software needs to be updated.
3. The method of claim 1, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise re-contacting the server at a later point or later points in times to retrieve one or more software parts.
4. The method of claim 1, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise contacting one or more third part servers at a later point or later points in times to retrieve one or more software parts.
5. The method of claim 1, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise one or more installation tasks to be performed asynchronously at a later point or later points in time upon asynchronously obtaining one or more software parts.

6. The method of claim 1, wherein the method further comprises servicing one or more subsequent asynchronous requests from the client computer for software parts in accordance with the tasks listed in said task list.
7. The method of claim 6, wherein said servicing comprises asking the client computer to retry one or more of the subsequent asynchronous requests for software parts.
8. In a client computer, a method of operation comprising:
 - periodically checking in with a server to determine if the client computer's software needs to be updated;
 - receiving from the server an update task list listing one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software, upon determining the client computer's software needs to be updated; and
 - performing said one or more tasks asynchronously at a later point or later points in time to update the client computer's software.
9. The method of claim 8, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise re-contacting the server at a later point or later points in times to retrieve one or more software parts.
10. The method of claim 8, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise contacting one or more third part servers at a later point or later points in times to retrieve one or more software parts.
11. The method of claim 8, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise one or more installation tasks to be performed

asynchronously at a later point or later points in time upon asynchronously obtaining one or more software parts.

12. The method of claim 8, wherein the method further comprises scheduling asynchronous performance of said tasks.

13. An apparatus comprising:

storage medium having stored therein a plurality of programming instructions designed to accept check in by a client computer at a first point in time to determine if the client computer's software needs to be updated, and to provide the client computer with an update task list listing one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software, if it is determined that the client computer's software is to be updated; and

at least one processor coupled to the storage medium to execute the programming instructions.

14. The apparatus of claim 13, wherein the programming instructions are further designed to determine whether the client computer's software needs to be updated.

15. The apparatus of claim 13, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise re-contacting the apparatus at a later point or later points in times to retrieve one or more software parts.

16. The apparatus of claim 13, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise contacting one or more third part servers at a later point or later points in times to retrieve one or more software parts.

17. The apparatus of claim 13, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client

computer's software comprise one or more installation tasks to be performed asynchronously at a later point or later points in time upon asynchronously obtaining one or more software parts.

18. The apparatus of claim 13, wherein the programming instructions are further designed to service one or more subsequent asynchronous requests from the client computer for software parts in accordance with the tasks listed in said task list.

19. The apparatus of claim 18, wherein said programming instructions are further designed to ask the client computer to retry one or more of the subsequent asynchronous requests for software parts.

20. A client computer comprising:

storage medium having stored therein a plurality of programming instructions designed to periodically check in with a server to determine if the client computer's software needs to be updated, to receive from the server an update task list listing one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software, upon determining the client computer's software needs to be updated, and to perform said one or more tasks asynchronously at a later point or later points in time to update the client computer's software; and

at least one processor coupled to the storage medium to execute the programming instructions.

21. The client computer of claim 20, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise re-contacting the server at a later point or later points in times to retrieve one or more software parts.

22. The client computer of claim 20, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the

client computer's software comprise contacting one or more third part servers at a later point or later points in times to retrieve one or more software parts.

23. The client computer of claim 20, wherein said one or more tasks to be performed by the client computer asynchronously at a later point or later points in time to update the client computer's software comprise one or more installation tasks to be performed asynchronously at a later point or later points in time upon asynchronously obtaining one or more software parts.

24. The client computer of claim 20, wherein the programming instructions are further designed to schedule asynchronous performance of said tasks.

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Attorney's Docket No.: 109910-130358
Application No.: 09/768,658